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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

First Named Applicant: Plow	)	Art Unit: 3622
	)	
Serial No.: 09/922,201	)	Examiner: Lastra
	)	
Filed: August 2, 2001	)	STL9-2000-0037-US1
	)	
For: <b>SYSTEM, METHOD, AND COMPUTER</b>	)	March 28, 2005
<b>PROGRAM PRODUCT FOR SELECTIVELY</b>	)	750 B STREET, Suite 3120
<b>DISPLAYING INTERNET ADVERTISEMENTS</b>	)	San Diego, CA 92101
	)	

**APPEAL BRIEF**

Commissioner of Patents and Trademarks  
Washington, DC 20231

Dear Sir:

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal filed herewith.

**Table of Contents**

<u>Section</u>	<u>Title</u>	<u>Page</u>
(1)	Real Party in Interest.....	2
(2)	Related Appeals/Interferences.....	2
(3)	Status of Claims.....	2
(4)	Status of Amendments.....	2
(5)	Concise Explanation of Subject Matter in Each Independent Claim.	2
(6)	Grounds of Rejection to be Reviewed.....	4
(7)	Argument.....	4
App.A	Appealed Claims	
App.B	Evidence Appendix	
App.C	Related Proceedings Appendix	

1176-5.APP

CASE NO.: STL9-2000-0037-US1  
Serial No.: 09/922,201  
March 28, 2005  
Page 2

PATENT  
Filed: August 2, 2001

**(1) Real Party in Interest**

The real party in interest is IBM Corp.

**(2) Related Appeals/Interferences**

No other appeals or interferences exist which relate to the present application or appeal.

**(3) Status of Claims**

Claims 1, 2, 4, 8-12, 14, 16, 19-22, 26, 29, and 30 are pending and finally rejected, and the remaining claims have been canceled.

**(4) Status of Amendments**

No amendments are outstanding.

**(5) Concise Explanation of Subject Matter in Each Independent Claim, with Page and Figure Nos.**

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

Claim 1 recites a *computer-implemented* method for selectively displaying Internet advertisements. The method includes allowing a user to choose at least one advertisement channel from an advertisement channel menu (29, figure 3, page 7, lines 3-5) presenting plural advertisement channels, and displaying

1176-5-APP

CASE NO.: STL9-2000-0037-US1

Serial No.: 09/922,201

March 28, 2005

Page 3

PATENT  
Filed: August 2, 2001

advertisements at least partially based on what channel is selected by the user (figure 2, page 6, line 17 continuing to page 7, line 13). The method also includes displaying a menu of user definable advertising attributes (id.) The user definable attributes include at least one of: city, zip code, retailers, distance of travel to a retailer, means for delivery, retail only, or wholesale only (page 8, lines 19-22).

The references above are incorporated herein. Claim 11 sets forth a system for selectively displaying Internet advertisements that has a server (22, figure 1, page 5, line 4), a database (24, figure 1, id.) connected to the server, and a user computer (12, figure 1, page 4, line 18) connected to the server via an Internet connection. The server transmits plural Internet advertisements to the user computer, which includes a program for allowing a user of the user computer to determine a type of advertisement to display based on a user selection of one of plural advertisement channels, see references in preceding paragraph. Logic means are provided for displaying a menu of user definable advertisement attributes that include city, zip code, retailers, distance of travel to a retailer, means for delivery, retail only, or wholesale only (id.)

The references above are incorporated herein. Claim 22 recites a computer program device (page 6, lines 3-9) with means having logic means for selectively displaying Internet advertisements, including logic means for allowing a user to define advertising attributes, logic means for displaying advertisements at least partially based on the user defined attributes, and means (e.g., the monitors shown in figures 1, 3, and 5) for displaying at least one advertisement corresponding to a user selected advertisement channel. Logic means are provided for displaying a menu of user definable attributes, and logic means allow the user to establish the values of the user definable attributes. The user definable attributes include: advertisement type, city, zip code, retailers, distance of travel to a retailer, means for delivery, retail only, or wholesale only, see above references.

1175-5.A.PP

CASE NO.: STL9-2000-0037-US1

Serial No.: 09/922,201

March 28, 2005

Page 4

PATENT

Filed: August 2, 2001

The references above are incorporated herein. Claim 30 sets forth a computer-implemented method for viewing advertisements on a computer system. The method includes selecting at least one attribute in an advertising window for displaying advertisements, and viewing in the advertising window at least one of a series of advertisements corresponding to a selected attribute. Each advertisement within the series embodies the selected attribute. The attribute is selected from the group consisting of: advertisement type, city, zip code, retailers, distance of travel to a retailer, means for delivery, retail only, wholesale only, and advertisement channel.

**(6) Grounds of Rejection to be Reviewed on Appeal**

(a) Claims 1-5, 8-10, and 30 have been rejected under 35 U.S.C. §101 for reciting non-statutory subject matter.

(b) Claims 1-5, 8, 9, 11-16, 19, 20, 22-26, 29, and 30 have been rejected under 35 U.S.C. §102 as being anticipated by Rakavy et al., USPN 5,913,040.

(c) Claims 10 and 21 have been rejected under 35 U.S.C. §103 as being unpatentable over Rakavy et al. in view of Smith, USPN 6,615,248.

**(7) Argument**

As an initial matter, it is noted that according to the Patent Office, a new ground of rejection in an examiner's answer should be "rare", and should be levied only in response to such things as newly presented arguments by Applicant or to address a claim that the examiner previously failed to address, 69 Fed. Reg. 155 (August 2004), see, e.g., pages 49963 and 49980. Furthermore, a new ground of rejection must be

1176-S-APP

CASE NO.: STL9-2000-0037-US1  
Serial No.: 09/922,201  
March 28, 2005  
Page 5

PATENT  
Filed: August 2, 2001

approved by the Technology Center Director or designee and in any case must come accompanied with the initials of the conferees of the appeal conference, id., page 49979.

Additionally, in reviewing the file the undersigned notes that he called the SPE in November 2004, who represented that he agreed with the rejections and thus that prosecution would not reopened. It accordingly is expected that prosecution will not be churned by reopening, but instead that the SPE will comply with his prior representation and send this case to the Board without further ado, allowance excepted.

(a)

Somewhat incredibly, a non-statutory-based rejection of computer-implemented method claims has been maintained despite what MPEP §2106 approvingly says about such claims, despite the SPE having been alerted to this fact, and despite the examiner having been told and then failing to recognize the right answer on several occasions. In his latest, the examiner alleges that although the claims being rejected recite a computer-implemented method for doing something within the technological arts, and that while the bodies of the claims admittedly recite advertisements, what is recited in the bodies of the claims "are not necessary (sic) the same as the advertisements recited in the preamble because there is no phrase that indicates that they are linked". In other words, the examiner is imputing a slyness to Appellant that, if true, would be terrifying: mentioning admittedly statutory advertisements in a preamble but then surreptitiously playing bait-and-switch by referring in the body of the claim to advertisements that, unknown to anyone but extraordinarily suspicious examiners, *are completely different and non-statutory advertisements*.

The allegation of a lack of linkage between the preamble and the body of Claim 1 is unhinged from reality. The preamble explicitly states that the computer-implemented method "comprises the acts of", and

1176-5.APP

CASE NO.: STL9-2000-0037-US1  
Serial No.: 09/922,201  
March 28, 2005  
Page 6

PATENT  
Filed: August 2, 2001

then follows that very real linkage with a recitation of various elements. Thus, there is no way to read the body of Claim 1 as "not being linked" with the preamble unless it is not understood what the phrase "comprises the acts of" means.

Furthermore, Claim 1 is statutory regardless of its status as a computer-implemented claim. It seems to be the examiner's position that allowing a user to choose an advertisement channel from an advertisement channel menu, displaying the ads, and displaying a menu of user definable advertising attributes which include some very specific filtering is not in the technological arts, despite, as admitted by the examiner, producing a concrete, tangible result. But this is not a legitimate, reasoned rejection, rationally understood. Rather, it is a mere legal conclusion unsupported by any findings of fact based on evidence of record. Just because the examiner thinks that allowing a person to select advertising channels is not within the technological arts does not make it so, unless the examiner has discovered, during his feckless search for "linkage" between the preamble and the claim body, a magic wand giving him unlimited powers.

(b)

Independent Claims 1, 11, 22, and 30 now respectively recite limitations that have been rejected based on the allegation that they are taught in Rakavy et al., col. 7, lines 42-62 and col. 9, lines 15-50. In fact, the rejected limitations do not appear anywhere in the cited sections. Column 7 teaches allowing users to configure the system on their desktops. It mentions that a "scheduler" schedules time dependent ads for display, and that a "feedback manager" sends user preferences, statistics, and feedback information to the server. Nowhere does col. 7, lines 42-62 teach or suggest that the user gets to define advertisement attributes

1176-5 APP

CASE NO.: STL9-2000-0037-US1

Serial No.: 09/922,201

March 28, 2005

Page 7

PATENT

Filed: August 2, 2001

that include city and/or zip code and/or retailers and/or distance of travel to a retailer and/or means for delivery and/or retail only and/or wholesale only, as otherwise required by, e.g., Claim 1.

For completeness, Appellant will also slog on and prove another negative, this time about col. 9, lines 15-50. Here, the user is allowed to configure the behavior of the system by inputting and viewing ad category preferences and computer configuration data, the latter including name, disk space, length of time an ad is stored before purging, communication overhead, screen saver delay time, and whether feedback can be sent to the network. Also, included in this section of col. 9 are listings of ad categories by priority and screening, time periods for displaying certain ads, whether wallpaper ads and/or animation are allowed, and the identification of the user's natural language.

But no hint of user-defined city as an ad attribute.

Or user-defined zip code as an ad attribute.

Or user-defined retailers as an ad attribute.

Or user-defined distance of travel to a retailer as an ad attribute.

Or user-defined for delivery as an ad attribute.

Or user-defined retail only as an ad attribute.

Or user-defined wholesale only as an ad attribute.

(c)

The proffered suggestion to combine Rakavy et al. with Smith flunks the requirement of MPEP §2143.01. Specifically, nothing in Rakavy et al. motivates one to display both TV and Internet advertising. Smith has nothing to do with advertisements at all (doesn't even mention it); consequently it cannot supply

1176-S.APP

CASE NO.: STL9-2000-0037-US1

Serial No.: 09/922,201

March 28, 2005

Page 8

PATENT

Filed: August 2, 2001

the required *prior art* motivation. Indeed, were these two references to be combined as proposed Rakavy et al. would simply display its Internet ads, along with the TV and Internet non-advertising content of Smith.

But that's not what the claims rejected under this section recite.

Respectfully submitted,



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11763.APP



CASE NO.: STL9-2000-0037-US1  
Serial No.: 09/922,201  
March 28, 2005  
Page 9

PATENT  
Filed: August 2, 2001

#### APPENDIX A - APPEALED CLAIMS

1. A computer-implemented method for selectively displaying Internet advertisements, comprising the acts of:

allowing a user to choose at least one advertisement channel from an advertisement channel menu presenting plural advertisement channels;

displaying advertisements at least partially based on what channel is selected by the user;

displaying a menu of user definable advertising attributes, wherein the user definable attributes include at least one of: city, zip code, retailers, distance of travel to a retailer, means for delivery, retail only, or wholesale only.

2. The method of Claim 1, further comprising the act of:

allowing the user to create an advertisement window in which advertisements are displayed.

4. The method of Claim 1, further comprising the act of:

allowing the user to establish the values of the user definable attributes.

8. The method of Claim 1, further comprising the act of:

displaying at least one advertisement corresponding to a user selected advertisement channel.

9. The method of Claim 1, wherein the advertisement channel menu includes at least one of: a travel advertisement channel, a food advertisement channel, an automotive advertisement channel, a clothing

1176-S.APP

CASE NO.: STL9-2000-0037-US1

Serial No.: 09/922,201

March 28, 2005

Page 10

PATENT  
Filed: August 2, 2001

advertisement channel, a music advertisement channel, a movie advertisement channel, an antiques advertisement channel, a hardware advertisement channel, a sporting goods advertisement channel, a housewares advertisement channel, an art supplies advertisement channel.

10. The method of Claim 1, wherein the advertisements are displayed at a device that receives Internet content and television broadcast content.

11. A system for selectively displaying Internet advertisements, comprising:

at least one server;

at least one database connected to the server, the database storing plural Internet advertisements;

at least one user computer connected to the server via an Internet connection, the server transmitting plural Internet advertisements to the user computer, the user computer including a program for allowing a user of the user computer to determine a type of advertisement to display at least in part based on a user selection of one of plural advertisement channels, wherein the program further comprises:

logic means for displaying a menu of user definable advertisement attributes, wherein the user definable attributes include: city, zip code, retailers, distance of travel to a retailer, means for delivery, retail only, or wholesale only.

12. The system of Claim 11, wherein the program comprises:

1176-5.APP

CASE NO.: STL9-2000-0037-US1  
Serial No.: 09/922,201  
March 28, 2005  
Page 11

PATENT  
Filed: August 2, 2001

logic means for allowing a user to define attributes; and

logic means for displaying advertisements at least partially based on the user defined attributes.

14. The system of Claim 11, wherein the program further comprises:

logic means for allowing the user to establish the values of the user definable advertisement attributes.

16. The system of Claim 11, wherein the program further comprises:

logic means for displaying a menu of advertisement channels.

19. The system of Claim 16, wherein the menu of advertisement channels includes at least one of: a travel advertisement channel, a food advertisement channel, an automotive advertisement channel, a clothing advertisement channel, a music advertisement channel, a movie advertisement channel, an antiques advertisement channel, a hardware advertisement channel, a sporting goods advertisement channel, a housewares advertisement channel, an art supplies advertisement channel.

20. The system of Claim 11, wherein the program further comprises:

logic means for allowing the user to create an advertisement window in which advertisements are displayed.

1176-5.APP

CASE NO.: STL9-2000-0037-US1

Serial No.: 09/922,201

March 28, 2005

Page 12

PATENT

Filed: August 2, 2001

21. The system of Claim 11, further comprising:

at least one television connected to the server via an Internet connection, the server transmitting plural Internet advertisements to the television, the television including a program for selectively displaying Internet advertisements.

22. A computer program device, comprising:

a computer readable means having logic means for selectively displaying Internet advertisements, comprising:

logic means for allowing a user to define advertising attributes;

logic means for displaying advertisements at least partially based on the user defined attributes;

means for displaying at least one advertisement corresponding to a user selected advertisement channel;

logic means for displaying a menu of user definable attributes;

logic means for allowing the user to establish the values of the user definable attributes, wherein the user definable attributes include: advertisement type, city, zip code, retailers, distance of travel to a retailer, means for delivery, retail only, or wholesale only..

26. The program device of Claim 22, wherein the computer readable means further comprises:

logic means for displaying a menu of advertisement channels.

1176-5 APP

CASE NO.: STL9-2000-0037-US1  
Serial No.: 09/922,201  
March 28, 2005  
Page 13

PATENT  
Filed: August 2, 2001

29. The program device of Claim 26, wherein the menu of advertisement channels includes at least one of: a travel advertisement channel, a food advertisement channel, an automotive advertisement channel, a clothing advertisement channel, a music advertisement channel, a movie advertisement channel, an antiques advertisement channel, a hardware advertisement channel, a sporting goods advertisement channel, a housewares advertisement channel, an art supplies advertisement channel.

30. A computer-implemented method for viewing advertisements on a computer system, comprising the acts of:

selecting at least one attribute in an advertising window for displaying advertisements; and

viewing in the advertising window at least one of a series of advertisements corresponding to a selected attribute, wherein each advertisement within the series embodies the selected attribute, wherein the attribute is selected from the group consisting of: advertisement type, city, zip code, retailers, distance of travel to a retailer, means for delivery, retail only, wholesale only, and advertisement channel.

1176-S.APP

CASE NO.: STL9-2000-0037-US1  
Serial No.: 09/922,201  
March 28, 2005  
Page 14

PATENT  
Filed: August 2, 2001

## APPENDIX B - EVIDENCE

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1176-S.APP

CASE NO.: STL9-2000-0037-US1  
Serial No.: 09/922,201  
March 28, 2005  
Page 15

PATENT  
Filed: August 2, 2001

### APPENDIX C - RELATED PROCEEDINGS

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1176-5.APP